REMARKS

This Response, submitted in reply to the Office Action dated September 15, 2005, is

believed to be fully responsive to each point of rejection raised therein. Accordingly, favorable

reconsideration on the merits is respectfully requested.

Claims 1-15 are all the claims pending in the application.

I.   Claim Rejections under 35 U.S.C. § 101

Claims 1-6 have been rejected under 35 U.S.C. § 101. The Examiner asserts that claims

1-6 appear to recite only non-statutory subject matter because the claims allegedly are directed to

software alone without claiming associated computer hardware. Further, the Examiner states

that the claimed steps do not define a machine or computer implemented process and therefore

are not directed to statutory subject matter.

Claim 1 recites "A method for providing prerequisite checking in **a system** for creating

compilations from a plurality of content objects stored in a data repository..." Claim 6 recites

"A program storage device **readable by a machine, tangibly embodying a program of**

instructions executable by the machine to perform method steps for providing prerequisite

checking in a system for creating compilations from a plurality of content objects stored in a

data repository, each content object comprising a plurality of content entities, some of the

content entities being prerequisites to others of the content entities..." Contrary to the

Examiner's assertions, claim 1 recites a system and 6 recites a device, both of which are statutory

subject matter.

Further, the standard for statutory subject matter is not whether the claims "define a

machine or a computer implemented" process, but rather whether the method produces a useful,

concrete and tangible result. See *Ex parte Lundgren*, Appeal No. 2003-2088, p. 9 (Bd. Pat. App. & Inter. 2005) ("Our determination is that there currently is no judicially separate 'technological arts' test to determine patent eligible subject matter under § 101."). Here, claims 1 and 6 clearly recite a useful, concrete and tangible result, for instance, "upon addition or removal of a content entity to or from the compilation, determining if the content entity has any prerequisite content entities, and if so, adding or removing the prerequisite content entities." Accordingly, it is respectfully submitted that claims 1 and 6 and their dependent claims recite statutory subject matter in compliance with 35 U.S.C. § 101.

II.   Claim Rejections under 35 U.S.C. § 102

Claims 1-15 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Tabuchi et al. (U.S. Patent No. 6,606,633). Applicant respectfully traverses the rejection since Tabuchi does not teach or suggest all of the claimed elements.

Tabuchi, as its title indicates, discloses a compound document management system and structure managing method. When a user wants to add a text, graph, or image to a compound document, an application program, such as a word processor, searches a structuring rule table 121 in a schema object 120 to determine if a structuring rule exists with respect to the text, graph or image to be added. If such a structuring rule exists, the user is allowed to insert the text, graph or image. If such a rule does not exist, then the user is not allowed to insert the text, graph or image. See col. 10, lines 5-28. These structuring rules can be added or deleted from the structuring rule table. See col. 10, lines 60-67.

Claim 1

Claim 1 recites "A method for providing prerequisite checking in a system for creating

compilations from a plurality of content objects stored in a data repository..." The Examiner

appears to be citing compound document 1100 (see Fig. 7) of Tabuchi for teaching the claimed

compilation. Further, the Examiner appears to be citing Tabuchi's discussion of inserting text,

graphs and images (presumably the content objects) into the compound document 1100 for

teaching a plurality of content objects stored in a data repository. However, Tabuchi discloses

storing text, graphs and images in data object 130 which is a data object, not a data repository as

claimed.

Claim 1 also recites "*each content object* comprising a plurality of content entities..."

Assuming *arguendo,* the Examiner is citing Tabuchi's text, graphs and images for teaching the

claimed content object, those text, graphs and images would not also correspond to *a plurality of*

content entities.

The Examiner appears to be citing Tabuchi's structure rules for teaching "some of the

content entities being prerequisites to others of the content entities," as further recited in claim 1.

However, Tabuchi describes the text, graphs, or images, asserted in the Office Action as being

the "content object comprising a plurality of content entities," as being different than structure

rules. The structure rules are stored in a schema object 120, and data objects such as text,

graphs, and images, are added to the compound document object according to the structure rules.

If a user desires to add a data object and a structure rule does not exist, a structure rule can be

added. Clearly a person of ordinary skill in the art would not confuse Tabuchi's structure rules

as the aforementioned text, graphs, or images (the alleged "content object comprising a plurality

of content entities"). Hence, even if Tabuchi's structure rules are deemed to define prerequisite conditions, since the structure rules are not "content entities," the claim limitation is not met.

Claim 1 further recites "upon addition or removal of a content entity to or from the compilation, determining if the content entity has any prerequisite content entities, and if so, adding or removing the prerequisite content entities." The Examiner asserts that the addition or removal of the structure rules from the structure rule tables teaches this aspect of the claim. However, as discussed above, a person of ordinary skill in the art would not understand Tabuchi's structure rule to be a "content entity" as required by the claims. Moreover, a structure rule is not added to or removed from the compilation (compound document as asserted by the Examiner, see Fig. 7) according to *prerequisite* content entities (structure rules as asserted by the Examiner). In particular, Tabuchi does not teach or suggest that the structure rules (content entities as cited by the Examiner) are *prerequisites* to other structure rules.

For at least the above reasons, claims 1, 6 and 11 and their dependent claims should be deemed allowable.

Claim 4

Claim 4 recites "in the case of more than one rules pertaining to the same prerequisite, further comprising the step of reducing the rule set if possible into a smaller set of rules." The Examiner asserts that col. 11, line 11 and Fig. 5 of Tabuchi teaches this aspect of the claim. The respective column and lines cited by the Examiner disclose the deletion of a structuring rule if the structuring rule is not used in a compound document object. This portion of Tabuchi does not teach or suggest that in the case of **more than one** rule pertaining to the **same prerequisite** of reducing the rule set if possible into a smaller set of rules.

For at least the above reasons, claim 4 should be deemed allowable. Since claims 9 and

14 recite similar elements, claims 9 and 14 should be deemed allowable for similar reasons.

III.   Conclusion

In view of the above, reconsideration and allowance of this application are now believed

to be in order, and such actions are hereby solicited. If any points remain in issue which the

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is

kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue

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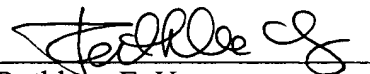
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Respectfully submitted,

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